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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,812	10/30/2003	Tania W. Hanna	43562.0300	9579

7590 06/22/2004

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EXAMINER

PRUNNER, KATHLEEN J

ART UNIT PAPER NUMBER

3751

DATE MAILED: 06/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/697,812	HANNA, TANIA W.	
	Examiner	Art Unit	
	Kathleen J. Prunner	3751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>060404</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. **Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading.** If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.
- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.
- (i) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

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2. The disclosure is objected to because of the following informalities: (A) the title of the invention and the section headings are in bold type; (B) on page 1, the status of the parent application should be updated. Appropriate correction is required.
3. The following informalities in the specification are noted: (A) on page 9, line 32, "preferable" should read --preferably--; and (B) on page 8, line 26, --a-- should be inserted before "longitudinal". Appropriate correction is required.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claim 3 is rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility. Claim 3 calls for each of the holders to hold "one or more" tool(s). However, the disclosure fails to support or describe how each holder can hold more than one tool at any one time or how the device would function when each holder holds more than one tool.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 3 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 3 calls for each of the first and second holders to be "configured to hold 'one or more' " tool(s). However, the disclosure fails to describe or support how each holder is so configured to hold more than one tool.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 2, 4, 5, 7-12, 16, 17 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Bolser. Bolser discloses a holder (constituted by coupling element 13) having all the claimed features including a main body having a first end and a second end (note Fig. 2), the first end having a first holder for holding a first cosmetic tool 11 and the second end having a second holder for holding a second cosmetic tool 12 (note lines 63-65 in col. 1), wherein at least one of the first holder or the second holder provides for releasably holding the first cosmetic tool or the second cosmetic tool (note lines 60-62 in col. 1), respectively, and wherein at least one of the first cosmetic tool 11 or the second cosmetic tool 12 is a conventional cosmetic tool designed for use as a separate unit not requiring the first holder or the second holder, respectively (note lines 63-66 in col. 1). With respect to claim 2, Bolser also discloses that the first holder provides for a friction fit between the first end and the first cosmetic tool and the second holder provides for a friction fit between the second end and the second cosmetic tool (note lines 63-65 in col. 1). With respect to claims 4 and 17, Bolser further discloses that the cosmetic tools have removable caps 28 and 58. With regard to claim 5, Bolser additionally discloses that the caps 28 and 58 include a snap fit (note lines 37-42 in col. 2 and 56-57 in col. 3). With regard to claim 7, Bolser also discloses that the caps are composed of plastic or metal (note lines 46-48 in col. 2 and Fig. 2). With respect to claim 8, Bolser additionally discloses that at least a portion of the cross-sectional shapes of the first and second caps has a combination of curved surfaces (note Figs. 1 and 2). With regard to claim 9, Bolser further discloses that at least a portion of the cross-sectional shape of the main body has a combination of curved surfaces (note Figs. 1 and 2).

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With regard to claim 10, Bolser also discloses that the main body, the first cap and the second cap have substantially the same cross-sectional shape (note Fig. 1). With respect to claim 11, Bolser further discloses that at least cap 28 has an exterior surface having a different cross-sectional shape than its interior surface (note Fig. 2). With regard to claim 12, Bolser additionally discloses that the first and second holders include an aperture or bore (note Fig. 2) for providing a friction fit with the tools 11 and 12 (note lines 63-65 in col. 1). With respect to claim 16, Bolser further discloses that the main body of holder 13 has a central axis (note Fig. 2) and that the first and second holders hold the tools 11 and 12 substantially parallel to the central axis so that the tools 11 and 12 extend from the ends of the main body (note Figs. 1 and 2). With respect to claim 20, Bolser also discloses the method of applying cosmetic products (note lines 51-56 in col. 1, line 18 in col. 3, and from line 58 in col. 3 to line 6 in col. 4) using a holder (constituted by coupling element 13) and conventional cosmetic tools 11 and 12 (note lines 63-66 in col. 1).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bolser in view of Kay et al. Bolser further discloses a fluid applicator having cosmetic tools that contain fluids that are either both nail polishes (note lines 7-8 in col. 1) or nail polish and nail polish remover (note lines 19-21 in col. 1). Although Bolser fails to disclose that the cosmetic tool fluids can be a lip product or eye product, attention is directed to Kay et al. who disclose another fluid applicator wherein the fluid to be dispensed or applied is a cosmetic fluid such as nail polish, lip liner, eye liner, eye shadow liner, and lip gloss and cream (note lines 35-41 in col. 3). It would

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have been obvious to one of ordinary skill in the cosmetic tool art, at the time the invention was made, to substitute for the nail cosmetic fluids of Bolser, the eye and lip cosmetic fluids as, for example, taught by Kay et al. wherein so doing would amount to mere substitution of one cosmetic fluid for another that would work equally well in the Bolser device.

12. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bolser in view of Kay et al. as applied to claim 3 above, and further in view of Bunk. Although Bolser and Kay et al. fail to disclose that at least one of the caps includes a reflective outer surface, attention is directed to Bunk who discloses another cosmetic tool for a lip product which has a reflective outer surface 32, 44 on the end wall of the cap in order to allow those applying the lip product to view their lips and thus eliminate the blind application of the lip product (note lines 55-59 in col. 2 and lines 53-57 in col. 4). It would have been obvious to one of ordinary skill in the cosmetic tool art, at the time the invention was made, to provide at least one of the caps of Bolser with a reflective outer surface in view of the teachings of Bunk in order to allow those applying lip product to view their lips and thus eliminate blind application of the lip product.

13. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bolser in view of Huang. Although Bolser fails to disclose that the holders include a threaded aperture for releasably holding a cosmetic tool having a matching threading, attention is directed to Huang who discloses another cosmetic tool in which the cosmetic tool is held in the end of the main body or coupling unit 70 by a threaded end in order to removably engage and align the axes of the cosmetic tools (note ¶ 0024). It would have been obvious to one of ordinary skill in the cosmetic tool art, at the time the invention was made, to threadingly mount the cosmetic tools within the main body of Bolser in view of the teachings of Huang in order to removably engage and align the axes of the cosmetic tools in a secure manner.

14. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bolser in view of Kageyama et al. ('693). Although Bolser fails to disclose the use of a chuck mechanism, attention is directed to Kageyama et al. who disclose another cosmetic tool (note lines 6-11 in col. 1) having a chuck 4 in which the replaceable article or tool 8 is mounted in order to allow for

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variations in the diameter or cross-sectional shape of the article or tool 8 (note lines 51-55 in col. 3). It would have been obvious to one of ordinary skill in the cosmetic tool art, at the time the invention was made, to provide at least one end of the main body of Bolser with a chuck mechanism for mounting the tool in view of the teachings of Kageyama et al. ('693) in order to allow for variations in the diameter or cross-sectional shape of a replaceable tool.

15. Claims 15, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bolser in view of Rosenthal. Although Bolser fails to disclose that at least one of the ends of the holder includes compressible material for releasably holding cosmetic tools having variable or different dimensions, attention is directed to Rosenthal who discloses another holder 12 having at least one end that includes a resilient, deformable, and thus compressible, member 36 at an end of the main body in order that sticks or tools of varying outer diameter can be supported therewithin (note lines 3-33 in col. 4 and Fig. 3). It would have been obvious to one of ordinary skill in the accommodating tool holder art, at the time the invention was made, to provide the main body of Bolser with a resilient, deformable, and thus compressible, member at least at one end in view of the teachings of Rosenthal in order that tools of varying outer diameter can be supported therewithin.

Conclusion

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Kathleen J. Prunner whose telephone number is 703-306-9044.

17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory L. Huson can be reached on 703-308-2580. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

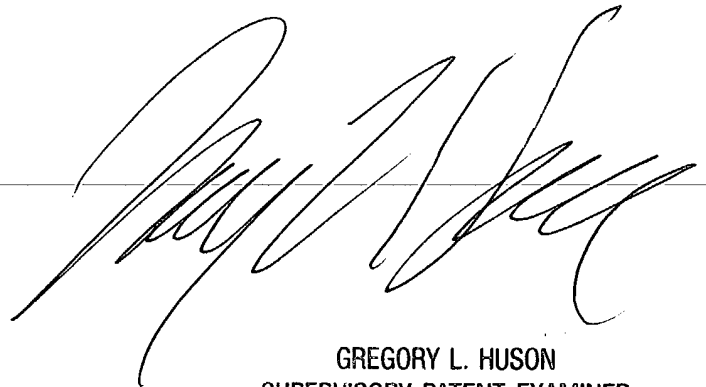
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18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kathleen J. Prunner

June 15, 2004



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